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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/785,271	02/24/2004	Craig A. Bonda	27702/10054B	3869

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EXAMINER	
LAMM, MARINA	

ART UNIT	PAPER NUMBER
1616	

DATE MAILED: 06/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/785,271	BONDA, CRAIG A.	
	Examiner	Art Unit	
	Marina Lamm	1616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-32 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1-32 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claims 1-32 are pending in this application filed 2/24/04, which is a continuation-in-part of co-pending application Serial No. 10/361,223, filed February 10, 2003, which is a continuation-in-part of co-pending application Serial No. 10/241,388, filed September 6, 2002.

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-32 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-35 of copending Application No. **10/361,223** ('223). An obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but an examined application claim is not patentably distinct from the reference claim(s) because the examined claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re*

Goodman, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985). Although the conflicting claims are not identical, they are not patentably distinct from each other because the presently claimed invention overlaps with that previously claimed. Thus, both inventions are directed to compositions comprising a mixture of (a) dibenzoylmethane derivative, (b) a α-cyano-β,β-diphenylacrylate compound and (c) a diester or polyester of naphthalene dicarboxylic acid. The instant claims recite the weight ratio of (b) to (c) of at least 0.95, while the copending application recites weight ratio of (b) to (c) of 0.1 or less. However, the determination of optimal or workable ratio of the compounds in the sunscreen composition by routine experimentation is obvious absent showing of criticality of the claimed ratio. One having ordinary skill in the art would have been motivated to do this to obtain the desired sunscreening properties of the composition.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

3. Claims 1-32 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-9, 11-16 and 18-50 of copending Application No. **10/241,388** ('388). Although the conflicting claims are not identical, they are not patentably distinct from each other because the presently claimed invention overlaps with that previously claimed. Thus, both inventions are directed to compositions comprising a mixture of (a) dibenzoylmethane derivative, (b) a α-cyano-β,β-diphenylacrylate compound and (c) a diester or polyester of

naphthalene dicarboxylic acid. The instant claims recite the weight ratio of (b) to (c) of at least 0.95, while the copending application recites weight ratio of (b) to (c) of less than 1:6. However, the determination of optimal or workable ratio of the compounds in the sunscreen composition by routine experimentation is obvious absent showing of criticality of the claimed ratio. One having ordinary skill in the art would have been motivated to do this to obtain the desired sunscreening properties of the composition.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

4. Claims 1-19 and 21-32 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 17 and 19 of U.S. Patent No. **5,993,789** ('789). Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1-17 and 24-32 are generic to all that is recited in claims 17 and 19 of '789. That is, Claims 17 and 19 of '789 fall entirely within the scope of claims 1-17 and 24-32 of the instant invention, or, in other words, Claims 1-17 and 24-32 are anticipated by Claims 17 and 19 of '789. Specifically, both inventions are directed to compositions comprising a mixture of dibenzoylmethane derivative, a diester or polyester of naphthalene dicarboxylic acid and α-cyano-β,β-diphenylacrylate compound. Further, both compositions may contain benzophenone (oxybenzone) and other UVA and/or UVB screening compounds.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-19 and 21-32 are rejected under 35 U.S.C. 102(b) as being anticipated by Bonda et al. (US 5,993,789).

Bonda et al. teach sunscreen compositions containing a mixture of dibenzoylmethane derivative and a diester or polyester of naphthalene dicarboxylic acid in the claimed concentrations. Further, the compositions of Bonda et al. may contain 0-10% of α-cyano-β,β-diphenylacrylate compound (octocrylene), oxybenzone (benzophenone-3), octyl methoxycinnamate and/or other sunscreening agents. See col. 2, lines 35-54, 64-67; col. 3-4; col. 7-8, Example 2; col. 8-10, Claims 1, 17. With respect to Claims 18 and 19, the recited dielectric constant of the oil phase is inherent to the compositions of Bonda et al. because they contain octocrylene, avobenzone (dibenzoylmethane derivative) and oxybenzone, which have high dielectric constants (11.08, 10 and 13, respectively).

Thus, Bonda et al. teach each and every limitation of Claims 1-19 and 21-32.

7. Claims 1-19 and 21-32 are rejected under 35 U.S.C. 102(e) as being anticipated by Gers-Barlag et al. (US 6,491,901 or US 2001/0022966).

Since both references appear to have identical disclosure, any reference hereinafter to paragraph numbers will be based upon the US publication disclosure.

Gers-Barlag et al. teach sunscreen compositions containing 0.1-10% of dibenzoylmethane derivatives, less than 1% of octocrylene, 4-16% of naphthalene dicarboxylic acid and 0.1-30% of other sunscreening agents, such as octyl methoxycinnamate, benzophenone, etc. See [0010]-[0012], [0014]-[0025], [0030]-[0032], [0036], [0038], [0039], [0047], [0082], [0083], Examples. With respect to Claims 18 and 19, the recited dielectric constant of the oil phase is inherent to the compositions of Gers-Barlag et al. because they contain octocrylene and dibenzoylmethane derivative, which have high dielectric constants (11.08 and 10, respectively).

Thus, Gers-Barlag et al. teach each and every limitation of Claims 1-19 and 21-32.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

9. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over either Bonda et al. ('789) or Gers-Barlag et al. in view of Bonda et al. (US 6,485,713).

Bonda et al. ('789) or Gers-Barlag et al. applied as above. Neither reference teaches the specific polar solvents of the instant claim. However, Bonda et al. ('713) teach that such solvents effectively dissolve the sunscreening compounds while reducing the rate of photodecay and, thus, increasing the stability of the sunscreening compounds. See col. 4, lines 5-55; col. 18, Table 3. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the composition of Bonda et al. ('789) or Gers-Barlag et al. such that to employ solvents of Bonda et al. ('713). One having ordinary skill in the art would have been motivated to do this to obtain more stable compositions as suggested by Bonda et al. ('713).

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US 6,555,095; US 6,444,195.

11. No claim is allowed at this time.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marina Lamm whose telephone number is (571) 272-0618. The examiner can normally be reached on Mon-Fri from 11am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman Page, can be reached at (571) 272-0602.

The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ml
6/19/04

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